

REMARKS

I. Introduction

With the addition of new claims 29 to 31, claims 15 to 31 are now pending. In view of the following remarks, it is respectfully submitted that claims 15 to 31 are allowable, and reconsideration is respectfully requested.

Applicants thank the Examiner for acknowledging the claim for foreign priority.

II. Objection to the Drawings

The Office Action objected to the drawings "because the boxes in figs. 1 & 2 should be labeled." In this regard, Figs. 1 and 2 have been amended to include descriptive legends for each of the boxes contained therein. Approval and entry of the drawings, as well as withdrawal of the objection to the drawings, are therefore respectfully requested.

III. Rejection of Claims 15, 16, 18-21, 23-26 and 28 under 35 U.S.C. § 103(a)

Claims 15, 16, 18-21, 23-26 and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,894,654 ("Serenbetz") in view of U.S. Reissued Patent No. 36,703 ("Heitschel") and U. S. Patent No. 4,931,789 ("Pinnow"). Applicants respectfully submit that these claims are allowable for at least the following reasons.

Claim 15 relates to a method for controlling a barricade of a parking space for a vehicle, in which the barricade is controlled from the vehicle by a code transmitted using a radio signal and checked with regard to an authorization of the code. Claim 15 further recites that the code is changed by an input, and that a plurality of codes are recognized as authorized for one barricade.

In contrast to claim 15, Serenbetz refers to method and apparatus to reserve parking spaces, in which a specially coded radio control is used to lower an obstruction when it is approached by a vehicle that should properly use the space. (See Serenbetz, Abstract). As acknowledged by the Office Action on page 2, Serenbetz fails to disclose that a code is changed by an input or that a plurality of codes are recognized as authorized for one barricade.

The Office Action asserts on page 3 that it would be obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Pinnow and Heitschel in Serenbetz to change to a code via an input with a display by the user and to recognize a plurality of user codes from the respective transmitter for convenience and security purpose. However, such an assertion to modify Serenbetz is not supported by the applied references,

and clearly improper. In particular, it is respectfully submitted that the Office Action's assertion that it would be obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Pinnow and Heitshel in Serenbetz "for convenience and security purpose" is mere hindsight reasoning and fails to demonstrate a requisite motivation.

To reject a claim as obvious under 35 U.S.C. § 103, the prior art must describe or suggest each claim element, and there must be a motivation or suggestion to modify or combine the elements in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). This motivation or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). In this regard, it is respectfully submitted that the Office has not provided proper citations to support the alleged motivation or suggestion to combine the prior art references.

Moreover, the cases of In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), also make plain that a subjective "obvious to try" standard is not proper. In particular, the Court in the case of In re Fine stated that:

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . **One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1600 (citations omitted; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943 & 1944 (citations omitted). In short, there must be evidence of why a person having ordinary skill in the art would be motivated to modify a reference to provide the claimed subject matter of the claims. Accordingly, combining these prior art references without evidence of a proper suggestion, teaching, or motivation "simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight." In re Dembiczak, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999).

In view of the foregoing, it is respectfully submitted that claim 15 is allowable. Claims 16, 18, and 19, which depend from claim 15 and therefore include all of its limitations, are also allowable for at least the same reasons that claim 15 is allowable.

Claims 20 and 26 recite limitations analogous to claim 15 and therefore are allowable for at least the same reasons that claim 15 is allowable. Claims 21 and 23-25, which depend from claim 20 and therefore include all of its limitations, are allowable for at least the same reasons that claim 20 is allowable. Claim 28, which depends from 26 and therefore includes all of its limitations, is allowable for at least the same reasons that claim 28 is allowable.

With regards to the Examiner's assertion that "using password is inherently included," it is respectfully submitted that to rely on inherency, the Office must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (M.P.E.P. § 2112) (emphasis in original). The Examiner has clearly not shown any evidence to support the conclusion that password use is necessarily included in the prior art teachings. For this additional reason, claims 16, 29, 30 and 31 are allowable over the applied references.

Independent of the above, none of the applied references teaches or suggests the claimed limitation of logging a dwell time of the vehicle in the parking space, as recited in claims 18 and 25. For this additional reason, claims 18 and 25 are allowable over the applied references.

In sum, it is therefore respectfully submitted that claims 15, 16, 18-21, 23-26 and 28 (as well as claims 29-31) are allowable over the applied reference for at least these reasons. Accordingly, the rejection of these claims under 35 U.S.C. § 103(a) should be withdrawn.

IV. Rejection of Claims 17, 22 and 27 under 35 U.S.C. § 103(a)

Claims 17, 22 and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Serenbetz in view of Heitschel, Pinnow, and knowledge the Examiner holds to be within the general skill of a worker in the art. Applicants respectfully submit that claims 17, 22 and 27 are allowable for at least the following reasons.

Claim 17, which depends from claim 15 and therefore includes all of its limitations, is allowable for at least the same reasons that claim 15 is allowable. Claim 22, which depends from claim 20 and therefore includes all of its limitations, is allowable for at least the same reasons that claim 20 is allowable. Claim 27, which depends from claim 26 and therefore includes all of its limitations, is allowable for at least the same reasons that claim 26 is

allowable.

It is also respectfully submitted that the Office Action's unsupported assertion that it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ Bluetooth in the combined references "for providing the same function as desired and a better system" is improper hindsight reconstruction for at least the same reasons discussed above in connection claim 15, and the alleged motivation or suggestion to combine the prior art references is simply not found in the prior art. For this additional reason, claims 17, 22 and 27 are allowable over the applied references.

Still further, it is respectfully submitted that a *prima facie* case of obviousness has not been made in the present case, since the Office Action never made any findings, such as, for example, regarding what the ordinary skill level in the art would have been at the time the claimed subject matter of the present application was made. (See In re Rouffet, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998) (the "factual predicates underlying" a *prima facie* "obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art")). It is respectfully submitted that the proper test for showing obviousness is what the "combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art," and that the Patent Office must provide particular findings in this regard -- the evidence for which does not include "broad conclusory statements standing alone." (See In re Kotzab, 55 U.S.P.Q. 2d 1313, 1317 (Fed. Cir. 2000) (citing In re Dembiczak, 50 U.S.P.Q.2d 1614, 1618 (Fed. Cir. 1999) (obviousness rejections reversed where no findings were made "concerning the identification of the relevant art," the "level of ordinary skill in the art" or "the nature of the problem to be solved")))). It is again respectfully submitted that there has been no such showing by the Office Action.

In fact, it is again respectfully submitted that the lack of any of the required factual findings in the Office Action forces Applicants to resort to unwarranted speculation to ascertain exactly what facts underly the present rejections. The law requires that the Patent Office provide the factual basis for rejecting a patent application under 35 U.S.C. § 103. (See In re Piasecki, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984) (citing In re Warner, 379 F.2d 1011, 1016, 154 U.S.P.Q. 173, 177 (C.C.P.A. 1967))). In short, the Office has failed to carry the initial burden of presenting a proper *prima facie* case of obviousness. (See In re Oetiker, 977 F.2d 1443, 1445, 24, U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992)).

V. New Claims 29 to 31

New claims 29 to 31 have been added herein. It is respectfully submitted that new claims 29 to 31 do not add any new matter and are fully supported by the present application, including the Specification. It is therefore respectfully submitted that these claims are allowable.

CONCLUSION

In view of all of the above, it is respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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